

REMARKS/ARGUMENTS

In response to the Office Action mailed December 19, 2008, Applicants amend their application and request reconsideration in view of the amendments and the following remarks. In this amendment, Claim 1 is amended, no claims have been added, or cancelled without prejudice, and claims 9 and 10 have been previously withdrawn so that Claims 1, 4, 5, and 9-10 are currently pending. No new matter has been introduced.

Claims 1 and 4 were rejected as being unpatentable over EP0041795A2 to Sehgal in view of U.S. Patent No. 5,891,845 to Myers. Claim 5 was rejected as being unpatentable over Sehgal in view of Myers and further in view of U.S. Patent No. 7,060,709 to Cooperstone et al. These rejections are respectfully traversed.

The MPEP, in section 706.02(j), sets forth the basic criteria that must be met in order to establish a *prima facie* case of obviousness:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaeck, 947 F.2d,488,20 USPQ2d 1438 (Fed.Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Section 2143.03 of the MPEP clarifies certain criteria in section 706.02(j).

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested

by the prior art. In *re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1074). "All words in a claim must be considered in judging the patentability of that claim against the prior art." In *re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. In *re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."

Sehgal discloses an injectable composition of rapamycin. The composition provides for 1 to 20 milligrams of rapamycin per milliliter of the composition and a nonionic surfactant. Various concentrations are illustrated. The injectable rapamycin composition comprises rapamycin, a nonionic surfactant and water. Upon removal of the solvent, the rapamycin remains in solution in the nonionic surfactant. Dilution of the above solutions containing rapamycin, solvent and nonionic surfactant or rapamycin and nonionic surfactant with water.

Myers discloses drug delivery systems utilizing liquid crystal structures. Myers discloses the use of vitamin E EPGS with cyclosporine.

Cooperstone discloses the use of a rapamycin 42-ester with 3-hydroxy-2-(hydroxymethyl)-2-methylpropionic and in the treatment of hepatic fibrosis and hepatic cirrhosis.

None of the references, whether taken alone or in combination disclose or suggest the invention of independent claim 1. Sehgal discloses an injectable composition of rapamycin that comprises no vitamin E and no ethanol in the final product. In addition, it is diluted with water for injection. There is no stable solution containing water. Myers discloses vitamin E TPGS/drug compositions. It is respectfully submitted that vitamin E TPGS has been known for at least 20 years as a water soluble version of vitamin E and as an excipient for pharmaceutical applications. Myers teaches a solid solution of vitamin E TPGS and a pharmaceutical agent. This is not a liquid solution utilizing water, but rather a binary system of equal amounts of

vitamin E and agent. Once again, no stable solutions and no reasons to combine since Sehgal dilutes with water only for IV use. A solid solution is blended on the molecular level and there is no use of water or co-solvents. In the present invention we utilize water and not a solid or molecular solution. The present invention also claims an aqueous solution, none of the other references discloses or suggests an aqueous solution. Copperstone adds nothing with respect to the rejection of claim 1. Accordingly, reconsideration and withdrawal of the rejection is respectfully requested.

Applicant would be grateful for the opportunity to conduct a telephonic or in-person interview of the Examiner believes it would be helpful in disposing of the present case.

A favorable action on the merits is earnestly solicited.

Respectfully submitted,

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